

Application/Control Number: 10/058,173  
Art Unit: 2122

Docket No.: PALM-3779

### **REMARKS**

Reconsideration and allowance in view of the foregoing amendment and the following remarks are respectfully requested.

By this amendment, claims 1-45 are pending, claims 1, 13, 14, 20, 23, 25, 35, and 37 having been amended, and claims 44 and 45 having been added. The specification is amended to correct typographical errors.

In the non-Final Office Action of January 3, 2005, the Examiner objected to claim 37 indicating that bullet item 'd' needs to be listed on a separate line; rejected claims 13, 20, 35, and 40 under 35 U.S.C. 112, second paragraph, for allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention; rejected claims 1-10, 14-17, 21, 37, 42, and 43 under 35 U.S.C. 102(b) as allegedly being anticipated by U.S. Patent No. 6,006,034 to Heath; rejected claims 11-13, 18-20, 22-36, and 38-41 under 35 U.S.C. 103(a) as allegedly being unpatentable over Heath in view of U.S. Patent No. 6,372,974 to Gross.

#### **Objection to Claim 37**

On page 2 of the Office Action, the Examiner objected to claim 37 indicating that bullet item 'd' needs to be listed on a separate line. Amended claim 37 now has bullet item 'd' on a separate line. Therefore, Applicant respectfully requests that the objection to claim 37 be withdrawn.

#### **Section 112 Rejection of Claims 13, 20, 35, and 40**

On page 2 of the Office Action, the Examiner rejected claims 13, 20, 35, and 40 under 35 U.S.C. 112, second paragraph, for allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Examiner indicated that the term "Bluetooth" is a trademark and therefore, is

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used to specify the source of so-labeled products. Applicant removed the term "Bluetooth" from the above-mentioned claims. Therefore, Applicant submits that the claims are definite and respectfully requests that the rejection of claims 13, 20, 35, and 40 be withdrawn.

**Rejection of Claims 1-10, 14-17, 21, 37, 42, and 43**

On page 3 of the Office Action, the Examiner rejected claims 1-10, 14-17, 21, 37, 42, and 43 under 35 U.S.C. 102(b) as allegedly being anticipated by Heath. Applicant submits that amended claims 1, 14, and 37 obviate the rejection. Applicant traverses the rejection with respect to claims 4, 15, and 43.

Amended independent claim 1 is directed to a method of software distribution. The method includes, among other things, demarking, via a user interface, a subset of a plurality of files stored on a first hand held computer system to denote a demarked plurality of files.

On pages 3 and 4 of the Office Action, the Examiner asserted that Heath discloses demarking a subset of a plurality of files. However, Applicant submits that Heath is completely devoid of any disclosure or suggestion of demarking, via a user interface, a subset of a plurality of files stored on a first hand held computer system to denote a demarked plurality of files, as required by claim 1.

Because Heath does not disclose or suggest each and every feature of claim 1, Applicant submits that claim 1 is not anticipated by Heath and respectfully requests that the rejection of claim 1 be withdrawn.

Claims 2-10 depend from claim 1 and are not anticipated by Heath for at least the reasons discussed above with respect to claim 1. Therefore, Applicant respectfully requests that the rejection of claims 2-10 be withdrawn.

Further, Applicant submits that claim 4 is also not anticipated by Heath for other reasons. For example, claim 4 further recites that the information of the demarked plurality of files comprises a rating of the demarked files.

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On page 4 of the Office Action, the Examiner asserted that Heath, at Fig. 3A:302-306, Fig. 2B, and col. 3, lines 7-20, discloses the above recited feature of claim 4. Applicant disagrees.

Fig. 3A: 302-306 describes a process in which a catalog file is retrieved from a server using a launcher, the launcher processes the catalog file, and the launcher unpacks the catalog file to initiate an application version check. Fig. 3A is devoid of any disclosure or suggestion of the feature required by claim 4.

Fig. 2B is a block diagram that illustrates a client requesting and receiving a catalog file and then requesting and receiving component files. Fig. 2B is devoid of any disclosure or suggestion of the feature required by claim 4.

Heath, at col. 3, lines 7-20, discloses:

Once the catalog file has been retrieved and processed in accordance with the method of the present invention, the status of each updating of the application program, including names of the components replaced, deleted or added on the client and related procedures, can be recorded in a file on the client for tracking and reporting the program usage and updates. Information in the downloaded catalog file, which at least includes the list of names and version identifications of the components for the updated application program, is stored on the client to be used in a subsequent update. The catalog file can also be specified to include a procedure to delete the components following the execution of the updated application program to free up disk space on the client.

Thus, Heath discloses that the status of each updating of an application program can be recorded and tracked.

Heath is completely devoid of any disclosure or suggestion that the information of the demarked plurality of files comprises a rating of the demarked plurality of files, as required by claim 4. Nevertheless, on page 4 of the Office Action, the Examiner improperly asserted that "information such as rating, for the purpose of sharing, could very well [sic] included in the catalog." Applicant submits that a proper rejection under section 102 is made when a single reference discloses each and every feature of the claim. Heath does not disclose or suggest each and every feature of claim 4.

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Further, Applicant submits that, because Heath does not disclose or suggest each and every feature of claim 4, the Examiner must have used impermissible hindsight to supply a feature, required by claim 4, but missing in the 102 reference to reject claim 4.

Amended independent claim 14 is directed to a method of software distribution. Claim 14 recites, among other things, on a second hand held computer system, selecting, via a user interface, a selected list indicating at least one of a plurality of demarked files. Applicant submits that Heath is silent regarding any disclosure or suggestion of, on a second hand held computer system, selecting, via a user interface, a selected list indicating at least one of a plurality of demarked files, as required by amended claim 14.

Because Heath does not disclose or suggest each and every feature of amended claim 14, Applicant submits that amended claim 14 is not anticipated by Heath and respectfully requests that the rejection of claim 14 be withdrawn.

Claims 15-17 and 21 depend from claim 14 and are not anticipated by Heath for at least the reasons discussed above with respect to claim 14. Therefore, Applicant respectfully requests that the rejection of claim 15-17 and 21 be withdrawn.

Further, Applicant submits that claim 15 is further not anticipated by Heath for other reasons. For example, claim 15 further recites that at least one of the files corresponding to the selected list transferred from the first hand held computer system to the second hand held computer system is a demonstration version of an application program. Applicant submits that this feature is not disclosed or suggested by Heath.

On page 6 of the Office Action, the Examiner asserted that Heath, at col.3, lines 7-20, discloses the feature of claim 15. Applicant disagrees.

Heath, at col. 3, lines 7-20, discloses that the status of each updating of an application program can be recorded and tracked. However, nothing in this portion of Heath or any other portion of Heath discloses or suggests that at least one of the files corresponding to the selected list transferred from the first hand held computer system to the second hand held

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computer system is a demonstration version of an application program, as required by claim 15.

Amended independent claim 37 is directed to a method of distributing software comprising, among other things, within a first hand held computer system, demarking a subset of a plurality of computer files via a user interface. This feature of claim 37 is similar to the previously discussed feature of claim 1. Applicant submits that claim 37 is not anticipated by Heath for at least reasons similar to those provided with respect to claim 1. Therefore, Applicant respectfully requests that the rejection of claim 37 be withdrawn.

Claims 42 and 43 depend from amended claim 37 and are not anticipated by Heath for at least the reasons discussed above with respect to claim 37. Therefore, Applicants respectfully request that the rejection of claims 42 and 43 be withdrawn.

Applicant further submits that claim 43 is not anticipated by Heath for reasons similar to those provided with respect to claim 5.

**Rejection of Claims 11-13, 18-20, 22-36, and 38-41**

On page 8 of the Office Action, the Examiner rejected claims 11-13, 18-20, 22-36, and 38-41 under 35 U.S.C. 103(a) as allegedly being unpatentable over Heath in view of U.S. Patent No. 6,372,974 to Gross. Applicant submits that amended claims 1, 14, 23, and 37 obviate the rejection. Applicant wishes to point out that claim 25 was amended only to correct a typographical error.

Claims 11-13 depend from claim 1, which is not anticipated by Heath for reasons discussed above with respect to claim 1. Applicant submits that Gross fails to satisfy the deficiencies of Heath. For example, Gross fails to disclose or suggest demarking, via a user interface, a subset of a plurality of files stored on a first hand held computer system to denote a demarked plurality of files, as required by independent claim 1. Therefore, Applicant respectfully requests that the rejection of claims 11-13 be withdrawn.

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Claims 18-20 and 22 depend from claim 14, which is not anticipated by Heath for at least the reasons provided above with respect to claim 14. Applicant submits that Gross fails to satisfy the deficiencies of Heath. Therefore, Applicant respectfully requests that the rejection of claims 18-20 and 22 be withdrawn.

Amended independent claim 23 is directed to a hand held computer system comprising, among other things, a memory, coupled to a bus, wherein the memory includes instructions, which when executed, implement a method of software distribution including, among other things, demarking, via a user interface, a subset of a plurality of files stored on a hand held computer system to denote a demarked plurality of files.

Applicant submits that Heath fails to disclose or suggest demarking, via a user interface, a subset of a plurality of files stored on a hand held computer system to denote a demarked plurality of files for at least reasons similar to those discussed above with respect to claim 1. Applicants further submit that Gross also fails to disclose or suggest this feature. Therefore, Applicant respectfully requests that the rejection of claim 23 be withdrawn.

Claims 24-36 depend from claim 23 and are patentable over Heath in view of Gross for at least the reasons discussed above with respect to claim 23. Therefore, Applicant respectfully requests that the rejection of claims 24-36 be withdrawn.

Claims 38-41 depend from claim 37, which is not anticipated by Heath for the reasons discussed above with respect to claim 37. Gross fails to satisfy the deficiencies of Heath. Therefore, Applicant respectfully requests that the rejection of claims 38-41 be withdrawn.

#### **New Claims 44 and 45**

New claims 44 and 45 recite features similar to those of claim 1, which is not anticipated by Heath for reasons discussed above. Applicant submits that the cited references fail to disclose or suggest all of the features of claims 44 and 45.

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**CONCLUSION**

Having addressed all rejections and objections, Applicant respectfully submits that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,

Date: March 31, 2005

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